

REMARKS/ARGUMENTS

The Office Action mailed May 12, 2003, and the references cited therein have been carefully reviewed in light of the Examiner's helpful comments and suggestions.

As a result of the Office Action, claims 1-3 are objected to on formal ground. Moreover, claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,987,106 to Kitamura in view of U.S. 6,141,058 to Lagoni. These references have been carefully reviewed but are not believed to show or suggest Applicant's invention as now claimed in any manner. Examination and allowance of the newly added claims is therefore respectfully requested in view of the following remarks.

By the above amendments, claims 1-3 have been cancelled and new claims 4-8 have been added. No new matter has been added. Applicant has carefully considered those objections during the preparation of new claims 4-8.

New claim 4 requires a main unit having a plurality of buttons and a picture/sound output hole for connection to the screen and the amplifier, an incoming call-detection circuit operably connected to a telephone line at one end and operably connected to the main unit at a second end, wherein said incoming-call detection circuit transforms messages of an incoming call into visual signals and outputs the visual signals.

The Examiner acknowledges that Kitamura fails to suggest or disclose "a main unit provided with buttons and picture/sound output hole for connection to an *amplifier* and wherein said incoming-call detection circuit transforms the messages of incoming call into visual signals and outputs said visual signals and displayed on the screen when an incoming

call is detected.” *Office Action*, page 3. For what Kitamura lacks in teaching, the Examiner has turned to Lagoni and combined the references. As a preliminary matter, Applicant respectfully submits that the Examiner has not provided a legally tenable “motivation” or “suggestion” to combine the teachings of those references. The sole evidentiary support that was provided to demonstrate the alleged motivation in the prior art to combine these teachings is as follows: “Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teaching of Lagoni et al into view of Kitamura in order to assist user in receiving telephone calls while operating his or her entertainment system at excessive level.” *Office Action*, page 4.

However, according to MPEP 2143.01, “[t]he level of skill can not be relied upon to provide suggestion to combine references.” In absence of specific motivation or suggestion taught by the prior art (See MPEP 2143: “The teaching and suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not in applicant’s disclosure.”), the obviousness rejection appears to have been improperly based solely upon the level of skill in the art.

Moreover, in support of the patentability of the pending claims, Applicant provides the following comments, where each of these comments independently supports the patentability of the claimed invention, such that a combination of these comments is not essential to demonstrate the patentability of the claimed invention.

First, according to MPEP 2143.01, the fact that the claimed invention would have been well within the ordinary skill in the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were

individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. Here, it seems the Examiner has found a reference that teaches a picture/sound equipment, namely Kitamura, and a second reference that teaches an amplifier and a detector unit, namely Lagoni, and has combined these references without any motivation or suggestion that can be found in the references. Applicant hereby requests legally appropriate documentary proof of such motivation pursuant to MPEP 2144.

Second, the fact that the prior art structure could be modified does not make such modification obvious in absence of the prior art suggesting the desirability of doing so. *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984). Here, the Examiner has provided no clue as to where support is found for the reasoning set forth as the suggestion to combine the references, and therefore it stands merely as the Examiner's unsupported opinion. In view of the foregoing, Applicant respectfully submits that claim 4 is patentable over prior art.

Claims 5-7 are dependent from claim 4 and is therefore allowable for the same reasons as in claim 4.

Claim 8 requires a method of displaying a caller's phone number on a screen, comprising the steps of providing an amplifier, providing a picture/sound out equipment having caller identification and volume adjustment feature, providing a main unit having a plurality of buttons and a picture/sound output hole, operably connecting the main unit to the screen and the amplifier, providing an incoming-call detection circuit having a first end and a second end, operably connecting the incoming-call detection circuit to a telephone line the first end and to the main unit at the second end, transforming the message of the incoming

call into visual signals by the incoming-call detection circuit. None of the prior art references, taken individually or in combination, teaches or suggests the method steps as required by claim 8. Therefore, it is respectfully submitted that claim 8 is also patentable over the prior art

The prior art references made of record by the Examiner have each been considered but are not believed to obviate against the allowability of the newly added claims. It is noted that none of these references have been specifically applied by the Examiner against any of the original claims.

Each issue raised in the Office Action mailed May 12, 2003, has been addressed and it is believed that claims 4-8 are in condition for allowance. Wherefore, Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,
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